



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/286,822	04/05/1999	THOMAS A. GRATE	MS1-305US	5476

22801 7590 03/21/2005

LEE & HAYES PLLC  
421 W RIVERSIDE AVENUE SUITE 500  
SPOKANE, WA 99201

EXAMINER

BLAIR, DOUGLAS B

ART UNIT	PAPER NUMBER
----------	--------------

2142

DATE MAILED: 03/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/286,822

Applicant(s)

GRATE ET AL.

Examiner

Douglas B Blair

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. Claims 1-39 are currently pending in the application.
2. The double patenting rejection is withdrawn in view of the terminal disclaimer filed 11/2/2004 with the amendment.

### ***Terminal Disclaimer***

3. The terminal disclaimer filed on 11/2/2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of the 6,052,710 patent has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Drawings***

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the process of automatically configuring a new trading relationship with a new trading partner using configuration details must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

Art Unit: 2142

5. Claims 1, 4, 8, 10, 15, 22, 27, 28, 29, 30, 33, and 39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The applicants' invention is directed to an automated configuration process that involves two phases. The first phase involves a conventional manner for publishing information to a web site. The first phase for publishing information to a web site is entirely well known in the art and numerous references cited by the examiner in previous office actions show such a feature. The second phase of the applicant's invention involves automatically creating and configuring a trading relationship for online exchanges with a potential trading partner. There is no disclosure in the applicant's specification that provides a means for fulfilling the enablement requirement with regard to automatically creating and configuring a new trading relationship. Page 10, lines 13-19 of the applicant's specification merely state that a trading partner record is created and automatically populated. Such a vague disclosure fails to put the public in possession of the invention.

The requirement for an adequate disclosure ensures that the public receives something in return for the exclusionary rights that are granted to the inventor by a patent. The grant of a patent helps to foster and enhance the development and disclosure of new ideas and the advancement of scientific knowledge (See M.P.E.P. Section 2162). There is nothing in the applicant's specification that helps to foster and enhance the development and disclosure of new

Art Unit: 2142

ideas and the advancement of scientific knowledge. Rather there is at best an abstract discussion of creating a trading relationship.

There is nothing within the applicant's specification that provides any guidance for one skilled in art to create a system for automatically creating a trading relationship, placing an undo burden of experimentation on anyone trying to implement the applicants claimed invention. For instance, there is no definition as to what a trading relationship is in the context of the applicant's invention. A person skilled in the art would have to figure out what defines a trading relationship, how funds are transferred, and what defines a trade. There are no details provided on how the first trading partners computer interfaces the second trading partner's computer to "automatically" create and configure a trading relationship. A person skilled in the art would have to figure out how to access get the first trading partners computer to access the second trading partner's web site and retrieve configuration details and once the details were obtained there is no guidance for how to make the first trading partners computer interface the second trading partner's computer, establishing the trading relationship.

In summary, the applicant's specification states that "the process is advantageous over prior art systems in that the trading relationships are established automatically" (page 10, lines 20-21). However, the applicant's specification fails to provide any direction for one try to implement a system establishing a trading relationship automatically.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2142

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 3, 8, 30, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 5,812,669 to Jenkins et al..
8. The art rejections are the same as those previously presented.
9. Claims 1-11, 13-17, and 19-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,490,567 to Gregory.
10. Claims 12 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,490,567 to Gregory in view of U.S. Patent Number 6,466,940 to Mills.
11. Claims 31 and 33-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 5,812,669 to Jenkins et al. in view of U.S. Patent Number 6,490,567 to Gregory.

### ***Response to Arguments***

Applicant's arguments filed 11/2/2004 have been fully considered but they are not persuasive. The applicant argues the following:

(a) With regard to the drawing objection, the applicant argues that automatically configuring a new trading relationship is adequately described in the specification with reference to the features as illustrated in the drawings. However, no details are shown to give someone trying to understand the applicant's invention any idea of what automatically configuring a new trading relationship comprises. Since the applicant is seeking patent protection for the concept of automatically creating a trading relationship there should be some information conveyed by the application about how that works.

Art Unit: 2142

(b) With regard to the 112 first paragraph rejection, the applicant cites portions of the specification that state that a trading relationship is created automatically but they fail to state *how* the trading relationship is created automatically. Merely stating that something can happen is not enabling. Details and descriptions are enabling and the applicant has cited none that show how the trading relationship is configured automatically.

In response to the office action's assertion that "there are not details provided on how the first trading partners computer interfaces the second trading partner's computer to automatically create and configure a trading relationship", the applicant states that the specification shows "each trading partner visits the other's Web site as identified by a URL to access the other trading partner's configuration details. The interfacing is performed using a network such as the Internet or other wide area network, interconnects the computer systems". This would imply that the applicant is trying to say that they invented the concept of accessing a URL over a network which is clearly a preposterous allegation.

(c) With regard to the art rejections, the claim language is extremely broad and the specification provides few details, therefore the current rejections read on the claimed subject matter.

With regard to the argument that it would be counterintuitive to establish a new trading partnership between the established trading parties, the applicant is misinterpreting the rejection. Jenkins teaches trading partners, the office action is acknowledging that Jenkins does explicitly teach a new trading partner. The concept of a trading partner being *new* is obvious however because at some point the trading relationship had to be established in Jenkins and therefore the partners would have been new to each other.

Art Unit: 2142

With regard to the argument that the merchant information is not configuration details associated with a new trading partner, the claim language does not define configuration details so the term is interpreted broadly. Though the specification may define some configuration details, this definition does not limit the scope of “configuration details” in the claims.

### ***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas B Blair whose telephone number is 571-272-3893. The examiner can normally be reached on 8:30am-5pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Jack Harvey can be reached on 571-272-3896. The fax phone numbers for the



Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3800.

Douglas Blair  
March 10, 2005

DBB

*Jack Henry*